

Honeywell Docket No. H0001324 - 4690
Bingham Docket No.: 7250022001-3225000

REMARKS

ELECTION/RESTRICTION

Applicant herein confirms the election made on March 15, 2005 of Group 1, claims 1-11 and 23-37. Claims 12-22 will be pursued in a divisional application, along with claims 23-26, which are herein canceled.

35 USC §102

Claims 1-8, 23-25 and 27-34 are rejected under 35 USC §102(b) as being anticipated by Bruneau et al (US 6,107,444). The Applicant respectfully disagrees.

Claim 1 recites:

“A plurality of micron-size solid particles, comprising at least one polyamide compound, wherein the particles comprise a diameter in the range of about 1 micron to about 1000 microns, and **wherein at least some of the plurality of particles are substantially transparent.**” (emphasis added)

The Examiner points to the Bruneau reference, column 1, lines 10-15 to show that the particles are transparent, but that contention is not correct. The Bruneau reference states in that section that the “parent thermoplastic” is transparent and that the parent thermoplastic contains polyamide particles. Then, the reference goes on to state that the sheets that contain the parent thermoplastic and the polyamide particles can act as a light scatterer. From the information given, it is neither clear nor inherent that the polyamide particles are transparent. For example, particles can act as light scatterers if they are opaque or colored or made out of more than one type of material. So, unless this reference points to the surprising fact that a) the particles are transparent and b) the particles are made by a method that ensures that the particles are uniform and transparent, then the Examiner is overreaching in the assumption that the polyamide particles are inherently transparent. The Applicant invites the Examiner to provide sufficient references that specifically point to the fact that polyamide particles are inherently transparent. In addition, the Applicant would like to point out that the present application defines the term “substantial” with respect to being “substantially transparent”.

The Bruneau reference does not anticipate the claims of the present application. “Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 148 USPQ 298, 301 (Ct.

Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)) Further, the prior art reference must disclose each element of the claimed invention “**arranged as in the claim**”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)(citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Bruneau reference does not recite or disclose transparent or substantially transparent polyamide particles. Based on this argument, along with others such as that discussed above, Bruneau does not anticipate claim 1 of the present application because Bruneau is lacking and/or missing at least one specific feature or structural recitation found in the present application, and in claim 1. Claim 1 is therefore allowable as not being anticipated by Bruneau. Further, Bruneau does not anticipate claims 2-11 of the present application by virtue of their dependency on claim 1.

Claims 23-25 are herein canceled in order to be pursued by a separate divisional application. Therefore, this rejection is moot.

Claim 27 recites:

“A plurality of micron-size solid particles, comprising at least one polyamide compound, wherein the particles **comprise a diameter of less than about 4 microns.**” (emphasis added)

The Bruneau reference suggests that the particles contemplated in Bruneau have a rather narrow particle size distribution, “that is to say that more than approximately 90% have a size of between 2.5 and 10 μm . However, it is still not clear from Bruneau that all of the particles have a particle diameter less than about 4 microns, as claim 27 in the present application recites. In the present application, claim 27, all of the particles must have a diameter of less than about 4 microns, and Bruneau does not appear to contemplate a collection of particles that are all smaller than about 4 microns. The reason that Bruneau does not anticipate the present application on this point is that the present application goes into great detail to describe how the contemplated particles are produced. This method that includes an emulsion (not a solvent) and a suspension agent along with a surfactant ensures that the particles will not only be transparent, but will be smaller than those particles found in the art and have a much narrower size distribution than those size distributions contemplated in the art, including Bruneau. The Applicant also would like to point out that the two European references

cited in Column 3 of the Bruneau reference - EP 192515 and EP 303530 - both use catalysts and solvents to produce the particles disclosed and do not contemplate the use of suspension agents and surfactants. This method of production for the particles contemplated by the present application cannot be overlooked as the primary reason for the superiority of the particles disclosed. Therefore, merely writing the particles in the present application off as “product by process” is an error.

The Bruneau reference does not anticipate the claims of the present application. “Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)) Further, the prior art reference must disclose each element of the claimed invention “**arranged as in the claim**”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Bruneau reference does not recite or disclose a very narrow size distribution of particles that are less than about 4 microns in diameter. Based on this argument, along with others such as that discussed above, Bruneau does not anticipate claim 27 of the present application because Bruneau is lacking and/or missing at least one specific feature or structural recitation found in the present application, and in claim 27. Claim 27 is therefore allowable as not being anticipated by Bruneau. Further, Bruneau does not anticipate claims 28-34 of the present application by virtue of their dependency on claim 27.

35 USC §103

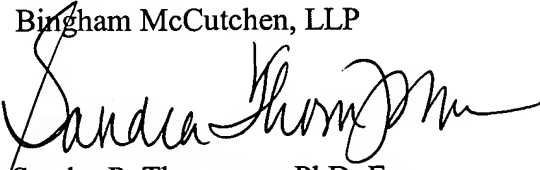
Claims 9-11, 26 (herein canceled) and 35-37 are rejected under 35 USC §103(a) as being unpatentable over Bruneau et al (US 6,107,444) as applied to claims 1-8, 23-25 (herein canceled) and 27-34 above, and further in view of Ogawa et al. (US 5,139,760). The Applicant respectfully disagrees.

In response to the Examiner's rejection, the Applicant reviewed the Ogawa reference in considerable detail. The Examiner has glossed over many of the subtle statements and descriptions in the Ogawa reference. For example, the alumina-silicate particles are incorporated into a polyamide to form sheets of material or resin molded products - not transparent particles that are less than about 1000 microns in size. It would not have been obvious at all for one of ordinary skill in the art to combine the Ogawa reference and combine it with the Bruneau reference, because the only thing that would tie the two references together is the mention of polyamide - which is not enough to teach or suggest a combination of the two to one of ordinary skill in the art. The Ogawa reference is not a proper prior art reference and therefore, should be removed. In addition, the Bruneau reference alone does not teach, suggest or motivate one of ordinary skill in the art to produce the products disclosed in claims 9-11 and 35-37, and therefore, the 103 rejection is improper and should be removed from further proceedings.

REQUEST FOR ALLOWANCE

Claims 1-11 and 27-37 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

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